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A/P

PATENT  
Attorney Docket No.: 20073-0107

IN THE UNITED STATE PATENT AND TRADEMARK OFFICE

#3

In re Patent Application of: )  
MICHAEL S. PETERS et al. )  
Serial No.: 08/229,526 )  
Filed: April 19, 1994 )  
For: MULTITHREADED BATCH )  
PROCESSING SYSTEM )  
Group Art Unit: Unknown  
Examiner: Unknown

PETITION TO THE COMMISSIONER UNDER 35 U.S.C. 1.47(a)

Honorable Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

Applicants hereby petition the Commissioner to permit the filing of the present application under 37 C.F.R. 1.47(a) since one of the joint inventors, David J. Arnold, Jr., has refused to sign a declaration for the present application.

The present application is a continuation of application Serial No. 08/203,531 which was filed February 28, 1994. This continuation was filed to correct the inadvertent omission of Mr. Arnold as an inventor in the above-referenced application. The parent application was abandoned on April 19, 1994.

On or about July of 1993, Mr. Richard D. Marks contacted Scott F. Partridge of the undersigned's firm concerning potential patent protection for Teleflex's products. The

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undersigned through the assistance of Teleflex, identified several features in one of Teleflex's products as potentially patentable. Early in the technical discussions related to the patent applications, Mr. Arnold was identified as an individual involved in the development of at least some of the potentially patentable features. Later in the patent application process, with counsel from the undersigned, Michael S. Peters identified Mr. Arnold as an inventor of the above-referenced patent application.

Since this time, efforts have been made to secure Mr. Arnold's signature on a declaration for the above-referenced patent application. To this date, Mr. Arnold has not signed a declaration or declared whether he will or will not do so in the future.

Applicants submit that Mr. Arnold's actions and his statements through his counsel constitute a refusal to sign the application in accordance with 37 C.F.R. § 1.47(a). In order to respond to the outstanding Notice to File Missing Parts without any additional extension of time fees being due, Applicants believe that filing this petition is necessary to prevent a potential loss of rights.

Mr. Arnold's last known address is as follows:

Home:        David J. Arnold, Jr.  
                  361 Worth Street  
                  Asheboro, North Carolina 27203

Attached is a copy of the Joint Declaration of Michael S. Peters and Clayton Walter Holt, who signed on their own behalf and on behalf of Mr. Arnold as set forth in 37 C.F.R. § 1.64 and MPEP § 409.03(a). The original Joint Declaration is being filed in response to the Notice to File Missing Parts. Also concurrently filed herewith is a

Declaration by Mr. Richard D. Marks stating the facts surrounding the refusal by Mr. Arnold to sign the above-referenced patent application.

A check in the amount of \$130.00 is enclosed to cover the fee required under 37 C.F.R. §§ 1.47(a) and 1.17(h). If any variance exists between the amount enclosed and the amount due, please charge applicant's representative's Deposit Account No. 02-0384.

Respectfully submitted,

BAKER & BOTTs, L.L.P.

By:   
Charles B. Lobsenz  
Registration No. 36,857

The Warner  
1299 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004-2400

Dated: September 1, 1994

(202) 639-7700

Enclosures



PATENT  
20073-0107

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of )  
Michael S. PETERS et al. )  
Serial No.: 08/229,526 ) Group Art Unit: Unknown  
Filed: April 19, 1994 ) Examiner: Unknown  
For: MULTITHREADED BATCH )  
PROCESSING SYSTEM )

Honorable Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

**DECLARATION BY RICHARD D. MARKS IN SUPPORT OF A  
PETITION TO MAKE APPLICATION UNDER 37 C.F.R. § 1.47(a)**

This declaration is made as to facts relied upon to establish the diligent effort made to secure the execution of a declaration by the omitted inventor for the above identified patent application.

1. I am an attorney at the law firm of Dow, Lohnes & Albertson, located in Washington, D.C.

2. The firm of Dow, Lohnes & Albertson, primarily through me, represents Teleflex Information Systems, Inc. ("Teleflex") in various legal matters.

3. On or about July of 1993, I contacted Scott Partridge of the firm of Baker & Botts, L.L.P., concerning potential patent protection for Teleflex's products.

4. Baker & Botts identified several features in one of Teleflex's products as potentially patentable.

5. On March 4, 1994, Teleflex filed suit against Mr. Arnold requesting, inter alia, that the court require Mr. Arnold to assign all rights in the subject patent

application to Teleflex as required under North Carolina law. This court action is still pending under a secrecy order in state court in North Carolina.

6. By virtue of Mr. Arnold's employment agreement with Teleflex and in view of the controlling case law, I believe that Mr. Arnold is under a duty to assign his rights in the subject patent application and any patent issuing thereon to Teleflex.

7. As part of discovery in connection with the lawsuit, on April 7, 1994, Mr. Arnold, through his attorney, Mr. Lee Corum, was provided with a copy of the parent of the above-referenced patent application as filed in the U.S. Patent and Trademark Office (PTO) including a Declaration which Mr. Arnold was asked to sign.

8. On April 29, 1994, Mr. Corum told me that he could not advise Mr. Arnold on whether or not to sign the declaration until he had secured a copy of all of the materials which were transmitted between Teleflex's representatives and the PTO.

9. Before May 1, 1994, I furnished a copy of the above-referenced patent application to Mr. Corum. *OIC*

10. On July 6, 1994, Mr. Sam Byassee, Teleflex's co-counsel in North Carolina, sent Mr. Corum a letter enclosing copies of other documents which had been filed on behalf of Teleflex in the PTO. A copy of this letter is attached at Tab A.

11. On July 26, 1994, I sent Mr. Corum another letter requesting that Mr. Arnold sign a declaration for the above-referenced patent application or to declare affirmatively his refusal to do so. A copy of this letter is attached at Tab B.

12. On August 3, 1994, Mr. Corum responded to my July 26, 1994 letter by indicating that he and his co-counsel were "unable to respond either affirmatively or negatively to the issue of whether ... D.J. Arnold, Jr., is willing to sign a declaration for each of the patent applications referenced above." A copy of Mr. Corum's letter is attached at Tab C. In that letter, Mr. Corum once again asked for more time and for additional correspondence between Teleflex and the PTO.

13. On August 5, 1994, I sent Mr. Corum a letter enclosing Notices to File Missing Parts and a Letter Regarding Drawings in connection with the subject application. In that letter, I reiterated the need for Mr. Arnold to file a declaration or, if he refused, to furnish an affirmative refusal to sign a declaration so that we could respond to the PTO's request without further delay. A copy of that letter is attached at Tab D.

14. To this date, Mr. Arnold still has not signed a declaration or said whether he will or will not do so in the future.

15. Given the need to respond to the Notice to File Missing Parts in the above-referenced application, the pattern of Mr. Arnold's ~~of~~ neither affirmatively or negatively declaring whether he will sign a declaration, and the time over which this pattern has persisted, I believe Mr. Arnold's overall conduct constitutes a refusal. RJM

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful and false statements may jeopardize the validity of the application or any patent issued thereon.

Date: September 19, 1994

  
Richard D. Marks



SMITH HELMS MULLISS & MOORE, L. L. P.  
ATTORNEYS AT LAW  
GREENSBORO, NORTH CAROLINA

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TELEPHONE 919/755-8700  
FACSIMILE 919/628-7938

July 6, 1994

VIA FEDERAL EXPRESS

Lee L. Corum, Esquire  
Attorney At Law  
301 West Main Street, Suite 200  
Durham, North Carolina 27702

Re: Teleflex v. Arnold

Dear Lee:

We have reviewed carefully with Teleflex's patent counsel all material that it has filed in the U.S. Patent and Trademark Office. There is nothing concerning the initial applications that you have not already received. A few administrative filings, which followed the initial applications, are enclosed to complete Teleflex's production of all filed documents, but they do not affect the substance of the applications, which was the concern that you expressed about not having a complete set of documents filed with the patent office.

Now that you have confirmation that you have all relevant patent office filings, it is imperative that Mr. Arnold sign the appropriate affidavits of inventorship. We will give you a call in the next day or so to talk about when we can conclude this outstanding issue.

With best regards, I am

Very truly yours,

William Sam Byassee

WSB/lc  
Enclosures

bcc: Karen Post, Esquire ✓  
(w/enc.)  
Philip Smith, Esquire  
(w/out enc.)

FILE COPY



DOW, LOHNES & ALBERTSON

ATTORNEYS AT LAW

1255 TWENTY-THIRD STREET  
WASHINGTON, D. C. 20037-1194

RICHARD D. MARKS  
DIRECT DIAL NO.  
857-2565

TELEPHONE (202) 857-2500  
FACSIMILE (202) 857-2900

July 26, 1994

VIA U.S. EXPRESS MAIL -  
RETURN RECEIPT REQUESTED

Lee L. Corum, Esq.  
First Union National Bank Building  
301 West Main Street, Suite 200  
P.O. Box 1665  
Durham, North Carolina 27702

Re: Teleflex v. Arnold

Dear Lee:

It has been some time since we sent to you all the materials filed by Teleflex with the U.S. Patent Office. Now that you have had ample opportunity to examine all that information, it is time for D.J. Arnold either to sign a declaration for each of the patent applications, or for you, in your capacity as his attorney, to send me a letter stating that D.J. refuses to sign the applications.

As you are aware, we need to complete this step in order to continue the applications' processing, which in turn is necessary to protect both Teleflex's and D.J.'s rights. May I ask you to send me by next Wednesday, August 3, either D.J.'s signature on each of the applications or your letter stating that you are D.J.'s attorney and that, for whatever reasons you cite, D.J. refuses to sign the applications.

If you have a question about anything in this letter, please call me. If I am unavailable, please speak to my colleague, Karen Post (202/857-2541) or to Sam Byassee.

Sincerely yours,

  
Richard D. Marks

RDM:rdt

cc (w/encl.): W. Sam Byassee, Esq.  
Philip E. Smith, Esq.  
Karen A. Post, Esq.

cc (w/o encl.): Charles B. Lobsenz, Esq.



ROGER S. UPCHURCH  
NICK GALIFIANAKIS

LAW OFFICES  
**UPCHURCH & GALIFIANAKIS**  
P. O. Box 1611  
DURHAM, NORTH CAROLINA 27702

August 3, 1994

301 WEST MAIN STREET  
SUITE 200  
TELEPHONE (919) 682-5403

VIA FAX 202-857-2900

Richard D. Marks, Esq.  
Dow, Lohnes & Albertson  
1255 - 23rd St.  
Washington DC 20037-1194

Re: Three (3) Patent Applications with the  
following Serial Nos.:  
08/203,531  
08/203,191  
08/203,193

Dear Richard:

We are responding to your letter addressed to Lee Corum  
dated July 26, 1994.

We are unable to respond either affirmatively or negatively  
to the issue of whether our client, D. J. Arnold, Jr., is  
willing to sign a declaration for each of the patent  
applications referenced above.

The existence of the preliminary injunction entered in the  
case of Teleflex vs. Arnold, Guilford County, NC 94-CvS-4295,  
has created a severe impediment to our ability to give you a  
response. We are making every effort in this matter; however,  
we cannot presently give you a response because we need  
additional time.

Please confirm that you have provided us with not only all  
the documents filed with the U.S. Patent Office but all  
correspondence between Teleflex and the U.S. Patent Office. If  
you have not furnished all said documents, please provide them  
in order to facilitate our decision.

With best regards, I am

Sincerely,

Nick Galifianakis



LLC:ms

CC: W. Sam Byassee, via FAX and U.S. Mail

DOW, LOHNES & ALBERTSON

ATTORNEYS AT LAW

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FACSIMILE (202) 857-2900

KAREN A. POST

DIRECT DIAL NO.

857-2541

CABLE "DOWLA"

TELEX 425546

August 5, 1994

- **VIA FACSIMILE AND U.S. EXPRESS MAIL -**
- **RETURN RECEIPT REQUESTED**

Lee L. Corum, Esq.  
First Union National Bank Building  
301 West Main Street, Suite 200  
P.O. Box 1665  
Durham, North Carolina 27702

Re: Teleflex v. Arnold

Dear Lee:

As my July 26, 1994 letter stated, we have sent you all the materials filed by Teleflex with the U.S. Patent and Trademark Office (PTO). This letter will confirm, once again, that this is the case. Your August 3, 1994 letter, for the first time, however, also requests copies of any correspondence between Teleflex and the PTO regarding the three pending patent applications. Enclosed are copies of all such correspondence -- Notices to File Missing Parts for each application and a Letter Regarding Drawings. These pieces of correspondence should have no bearing whatsoever on your client's decision whether to sign a declaration for each of the patent applications. Moreover, issuance of the preliminary injunction in this case also should have no bearing on this decision.

Lee, any further delay with regard to this matter is unacceptable. Any potential rights that D.J. may have (as well as rights that Teleflex has) may be jeopardized if we do not complete this step of the application process. I need to hear from you

Lee L. Corum, Esq.  
August 5, 1994  
Page 2

immediately as to how D.J. plans to proceed. If I am unavailable when you call, please speak with Karen Post of my office, or to Sam Byassee.

Sincerely yours,

*Richard D. Marks* | KAP  
Richard D. Marks

Enclosure

cc (w/encl.):      W. Sam Byassee, Esq.  
                         Philip E. Smith, Esq.

cc (w/o encl.):      Charles B. Lobsenz, Esq.